REMARKS

35 U.S.C. § 102 Rejections

The Examiner has rejected claims 1-8, 10-13, and 18-19 under 35 U.S.C. § 102(b) as being anticipated by Kang. This includes the only independent claim. Applicant submits that these claims are not anticipated by Kang.

The Examiner states as follows:

As to claim 1, Kang et al. discloses an electronic package as shown in figures 1-5 comprising:
a first device (56) including a microelectronic die having an integrated circuit;
a second device (52) including a first thermal plate; and
a thermal interface material (54) between and in contact with surfaces of the first and second devices (56, 52), the thermal interface material including: at least one polyester matrix material (thermal polymer matrix); and at least one thermally conductive filler (filler paste) dispersed within the polyester matrix material.

The Examiner in the above-quoted section did not state where in Kang a polyester matrix is disclosed. Applicant has electronically searched Kang for "polyester," but could find no reference to it in Kang. Applicant has assumed that the Examiner has relied on the genus "polymer" for purposes of anticipating "polyester."

The question whether a prior genus anticipates a later species is more complicated. It is well settled that a valid patent may issue for a nonobvious improvement on a prior patented invention, even though the improvement falls within the claims of that prior patent. This suggests that a prior genus which does not explicitly disclose a species does not anticipate a later claim to that species. The genus, if later, would not infringe the species claim, at least not in all cases. Hence, it

does not anticipate. On the other hand, in *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.* (2001) (246 F.3d 1368), the Federal Circuit noted that "the disclosure of a small genus may anticipate the species of that genus even if the species are not themselves recited. *In re Petering*, 301 F2d 676, 682, 133 USPQ 275, 280 (CCPA 1962)." (246 F.3d at 1380.)

In *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics, Inc.* (1992) (976 F2d 1559), the Federal Circuit noted that "although [a patent's] specific claims are subsumed in [a prior art reference's] generalized disclosure ..., this is not literal identity." The reference's ranges were "so broad as to be meaningless" and provided no guidance on how to construct a product with the patent's beneficial properties.

In *Ultradent Products, Inc. v. Life-Like Cosmetics, Inc.* (1997) (127 F.3d 1354), the Federal Circuit held that substantial evidence supported a jury verdict that a patent claim to a functionally defined chemical composition was not anticipated by a prior art reference that disclosed a broad range of possible compositions.

In a similar fashion, the genus polymer does not anticipate polyester. Applicant therefore submits that claim 1 has at least one limitation that is not suggested by Kang, namely the limitation of a polyester.

Claims 7-8, 10-13, and 18-19 depend from claim 1, and should be allowable for at least the same reasons as claim 1.

Applicant, accordingly, respectfully requests withdrawal of the rejections of claims 1-8, 10-13, and 18-19 under 35 U.S.C. § 102(b) as being anticipated by Kang.

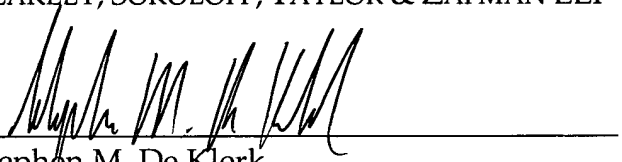
Applicant respectfully submits that the present application is in condition for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call Stephen M. De Klerk at (408) 720-8300.

Please charge any shortages and credit any overages to Deposit Account No. 02-2666. Any necessary extension of time for response not already requested is hereby requested. Please charge any corresponding fee to Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Date: December 20, 2006



Stephen M. De Klerk
Reg. No. 46,503

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, California 90025-1026
(408) 720-8300